

REMARKS

Applicants respectfully request reconsideration of the present Application based on the remarks below.

Rejections based on 35 U.S.C. § 103

A) Rejection based on Rajan, Murray, Harris, Arthur, and Adkins

Claims 1-9, 11 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2005/0165895 to Rajan, et al. (hereinafter “Rajan”) and further in view of U.S. Publication No. 2005/0080855 to Murray (hereinafter “Murray”) and further in view of U.S. Publication No. 2010/0153381 to Harris (hereinafter “Harris”) and further in view of U.S. Patent No. 7,640,305 to Arthur, et al. (hereinafter “Arthur”) and further in view of U.S. Publication No. 2004/0243844 to Adkins (hereinafter “Adkins”).

Applicants respectfully submit that the combination of references used in the present Office Action is improper in relation to independent claim 1. Initially, Applicants point out that Rajan teaches a system for handling spam messages that includes “a plurality of appropriately labeled directories for containing e-mails suspected of being spam, grading the level of spaminess of the incoming e-mails” such that the e-mails can then be moved into the appropriate directories. Rajan, Abstract. Independent claim 1, to the contrary, recites that messages are “*tagged with a junk rating which is added as an actionable property on the message such that the junk rating is displayed on a user interface in association with each respective message as a separate column so that a display of the messages can be visually altered based on the junk ratings of the messages by way of one or more display rules.*” This allows messages to be hidden or otherwise sorted in the inbox. As such, messages are not automatically placed in different folders or directories, as is the stated purpose of Rajan. “If

proposed modification would render the prior art invention being modified unsatisfactory for the intended purpose, then there is no suggestion or modification to make the proposed modification.” MPEP 2143.01(V) (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Applicants respectfully submit that modifying Rajan to allow for all of the messages to be displayed in a single folder or directory would render Rajan unsatisfactory for its intended purpose. The intended purpose of Rajan is clearly having a plurality of directories for each of several levels of spaminess assigned to each incoming message. This is directly contrary to the invention of claim 1. As this modification would render Rajan unsatisfactory for its intended purpose, Applicants respectfully submit that Rajan, in combination with the other cited references, is an improper combination. Applicants also submit that Rajan teaches away from the invention of claim 1, in that it clearly teaches that messages are moved to spam folders or directories before the messages are even viewable by the user in the inbox.

Rajan does state that an email may be placed in more than one directory, if it has characteristics of both of those directories. Rajan, ¶ [0032]. “Preferably, the email place in more than one directory would include a visual indication to the user that the email is contained in more than one directory and possibly prompting the user to take some action such as voting on its spaminess.” *Id.* As such, it is clear that not all e-mails are placed in multiple directories. Further, multiple directories may not include the inbox, which is where the e-mails in the invention of claim 1 are placed so that the user can act on the e-mails based on their respective spam levels.

Further, Applicants submit that the proposed modification to Rajan would change its principle of operation. “*If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of*

the references are not sufficient to render the claims prima facie obvious. MPEP 2143.01 (*citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” As previously mentioned, the principle of operation of Rajan includes a system that places incoming messages into various directories based on their respective level of spaminess. Modifying the system taught by Rajan would result in its principle of operation being changed, as well as would result in a change in the basic principle under which Rajan was meant to operate.

Additionally, Applicants respectfully submit that the proposed modifications to Murray would render it unsatisfactory for its intended purpose. Like Rajan, Murray’s intended purpose is scoring incoming messages and delivering the messages to a folder based on its level of spaminess. For instance, “if the categorized e-mail does not seem to be spam (block 114), the message is sent to the recipient (for instance, the message is sent to the recipient’s inbox) (block 104). However if the e-mail appears to be spam (block 114), it is sent to a spam folder (block 116). As such, the spam e-mail would not even show up in the user’s inbox. While this may be desirable in certain situations, it is contrary to the teachings of claim 1 of the present invention. For instance, claim 1 recites that messages are “*tagged with a junk rating which is added as an actionable property on the message such that the junk rating is displayed on a user interface in association with each respective message as a separate column so that a display of the messages can be visually altered based on the junk ratings of the messages by way of one or more display rules.*” This allows messages to be in a single folder such that the messages can be sorted/filtered/grouped according to their respective spam ratings (junk ratings/scores), which are visible in a separate column. The modification required for Murray, therefore, would be unsatisfactory for its intended purpose, as the whole point of Murray is to score the messages and place them in a folder based on this score. This is contrary to the invention of claim 1. Even

further, Murray teaches away from the invention of claim 1, as it clearly teaches placing spam messages in a separate folder before the messages are even viewable to the user in the inbox. This is a completely different approach to handling spam messages.

As such, for at least the above reasons, it is respectfully submitted that Rajan, Murray, Harris, Arthur, and Adkins, whether taken alone or in combination, fail to teach or suggest, either expressly or inherently, each and every element of independent claim 1, and, as such, claim 1 is not made obvious by these references. Additionally, the combination of these references is improper. As such, a *prima facie* case of obviousness has not been made. Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 103(a).

Claims 2-9 and 11-12 depend directly or indirectly from independent claim 1, and thus Rajan, Murray, Harris, Arthur, and Adkins fail to render this claim obvious as well for at least the same reasons as claim 1, as discussed herein. As such, Applicants request withdrawal of the rejection of claims 2-9 and 11-12 under 35 U.S.C. § 103(a). Claims 2-9 and 11-12 are believed to be in condition for allowance and such favorable action is respectfully requested.

B) Rejection based on Rajan, Murray, Harris, and Adkins

Claims 15, 17, 18, 21-26 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Rajan and further in view of Murray and further in view of Harris and further in view of Adkins.

Similar to that described above with respect to independent claim 1, Applicants respectfully submit that the combination of references used in the present Office Action is improper in relation to independent claim 15. Initially, Applicants point out that Rajan teaches a system for handling spam messages that includes “a plurality of appropriately labeled directories for containing e-mails suspected of being spam, grading the level of spaminess of the incoming

e-mails” such that the e-mails can then be moved into the appropriate directories. Rajan, Abstract. Independent claim 15, to the contrary, recites that messages are *“tagging the message with a junk rating which is added as an actionable property on the message such that the junk rating is displayed on a user interface in association with each respective message as a separate column so that a display of the messages can be visually altered based on the junk ratings of the messages by way of one or more display rules.”* This allows messages to be hidden or otherwise sorted in the inbox. As such, messages are not automatically placed in different folders or directories, as is the stated purpose of Rajan. *“If proposed modification would render the prior art invention being modified unsatisfactory for the intended purpose, then there is no suggestion or modification to make the proposed modification.”* MPEP 2143.01(V) (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Applicants respectfully submit that modifying Rajan to allow for all of the messages to be displayed in a single folder or directory would render Rajan unsatisfactory for its intended purpose. The intended purpose of Rajan is clearly having a plurality of directories for each of several levels of spaminess assigned to each incoming message. This is directly contrary to the invention of claim 15. As this modification would render Rajan unsatisfactory for its intended purpose, Applicants respectfully submit that Rajan, in combination with the other cited references, is an improper combination. Applicants also submit that Rajan teaches away from the invention of claim 15, in that it clearly teaches that messages are moved to spam folders or directories before the messages are even viewable by the user in the inbox.

Rajan does state that an email may be placed in more than one directory, if it has characteristics of both of those directories. Rajan, ¶ [0032]. “Preferably, the email place in more than one directory would include a visual indication to the user that the email is contained in

more than one directory and possibly prompting the user to take some action such as voting on its spaminess.” *Id.* As such, it is clear that not all e-mails are placed in multiple directories. Further, multiple directories may not include the inbox, which is where the e-mails in the invention of claim 15 are placed so that the user can act on the e-mails based on their respective spam levels.

Further, Applicants submit that the proposed modification to Rajan would change its principle of operation. *“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.* MPEP 2143.01 (*citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” As previously mentioned, the principle of operation of Rajan includes a system that places incoming messages into various directories based on their respective level of spaminess. Modifying the system taught by Rajan would result in its principle of operation being changed, as well as would result in a change in the basic principle under which Rajan was meant to operate.

Additionally, Applicants respectfully submit that the proposed modifications to Murray would render it unsatisfactory for its intended purpose. Like Rajan, Murray’s intended purpose is scoring incoming messages and delivering the messages to a folder based on its level of spaminess. For instance, “if the categorized e-mail does not seem to be spam (block 114), the message is sent to the recipient (for instance, the message is sent to the recipient’s inbox) (block 104). However if the e-mail appears to be spam (block 114), it is sent to a spam folder (block 116). As such, the spam e-mail would not even show up in the user’s inbox. While this may be desirable in certain situations, it is contrary to the teachings of claim 15 of the present invention. For instance, claim 15 recites that messages are “*tagging the message with a junk rating which is*

added as an actionable property on the message such that the junk rating is displayed on a user interface in association with each respective message as a separate column so that a display of the messages can be visually altered based on the junk ratings of the messages by way of one or more display rules.” This allows messages to be in a single folder such that the messages can be sorted/filtered/grouped according to their respective spam ratings (junk ratings/scores), which are visible in a separate column. The modification required for Murray, therefore, would be unsatisfactory for its intended purpose, as the whole point of Murray is to score the messages and place them in a folder based on this score. This is contrary to the invention of claim 15. Even further, Murray teaches away from the invention of claim 15, as it clearly teaches placing spam messages in a separate folder before the messages are even viewable to the user in the inbox. This is a completely different approach to handling spam messages.

As such, for at least the above reasons, it is respectfully submitted that Rajan, Murray, Harris, and Adkins, whether taken alone or in combination, fail to teach or suggest, either expressly or inherently, each and every element of independent claim 15, and, as such, claim 15 is not made obvious by these references. Additionally, the combination of these references is improper. As such, a *prima facie* case of obviousness has not been made. Applicants respectfully request withdrawal of the rejection of claim 15 under 35 U.S.C. § 103(a).

Claims 17-18, 21-26, and 29 depend directly or indirectly from independent claim 15, and thus Rajan, Murray, Harris, and Adkins fail to render this claim obvious as well for at least the same reasons as claim 15, as discussed herein. As such, Applicants request withdrawal of the rejection of claims 17-18, 21-26, and 29 under 35 U.S.C. § 103(a). Claims 17-18, 21-26, and 29 are believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-9, 11-12, 15, 17-18, 21-26, and 29 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 816-474-6550 or emcfarland@shb.com (such communication via email is herein expressly granted) – to resolve the same. It is believed that no fee is due, however, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112, with reference to Attorney Docket Number 308122.01/MFCP.149237.

Respectfully submitted,

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